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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,673	12/04/2003	Ronald W. Kolb	20030403.ORI	8471

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EXAMINER	
REESE, DAVID C	

ART UNIT	PAPER NUMBER
3677	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/727,673	KOLB, RONALD W.	
	Examiner	Art Unit	
	David C. Reese	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 March 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

[1] Claims 1-9 are pending.

Drawings

[2] New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings should exemplify more detail and better quality. Fig. 1, for example, though a general overview of the claimed invention, should still be of better quality and detail, so that paramount attributes and specifications of the claimed invention are more efficiently presented, and thus better differentiated from other art. Fig. 4 is another example, where it is difficult to view the relationship between the seat beads, the recess, and the seat. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

[3] Claims 1 and 7 are objected to because of the following informalities:

Misunderstanding in the claims since section (b) of Claim 7 states that the hook is formed at said **first portion** of the band; while in Claim 1, section (c) states that the same hook is at a **second portion** of said band.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

[4] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[5] Claims 1, 3, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson, US-2,811,024.

Thompson teaches of a ring having a bezel.

As for Claim 1, Thompson teaches of a ring comprising:

(a) a band (7 in Fig. 3);

(b) a hollow bezel (12) secured to a first portion of said band (25 onto 10) and having an open top (to the right of 17), and open bottom (14), an inside wall defining a lumen extending between said open top and said open bottom (13), a seat within said lumen (16), and an outside wall having a recessed section (20);

(c) a stone (15) mounted at least partially within said lumen (13) of said bezel and in contact with said seat (15 into 16); and

(d) a hook (21) at a second portion of said band (9) and having an opening (27) sized to receive the recessed section of said bezel (20), wherein when said hook has received the recessed section of said bezel (20 into 27, 22), the hook is impeded from either the top (above 20) or bottom (below 20) of said bezel.

As for Claim 3, Re: Claim 1, Thompson teaches of a ring wherein said band (9) has spring characteristics (part 3, line 64, stating, "In the initial position...toward the center of the head just far enough to be sprung slightly outwardly as...") such that the band (9), hook (21) and bezel (12) all cooperate to hold the inside of the hook (22) against the center section of the bezel (20) as the piece of jewelry is worn.

As for Claim 5, Re: Claim 1, Thompson teaches of a ring wherein the outside wall of said bezel (12) has a substantially hour-glass shape (due to the "concave exposed area in which is formed a socket" represented by 20 in Fig. 3; the concavity of the socket gives the outside wall a hour-glass shape).

Claim Rejections - 35 USC § 103

[6] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[7] Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson, US-2,811,024.

Thompson discloses the claimed invention except for stating that the ring holding the bezel comprises at least one metal wire. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to create an embodiment of ring that was comprised of metal wire, as well as obvious to change the medium for holding the clasp to that of a bracelet, necklace, etc, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

[8] Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson, US-2,811,024.

Thompson discloses the claimed invention except for stating that the ring holding the bezel comprises of at least one metal wire, including spring characteristics approximately between 5 and 7 dies hard. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to create an embodiment of ring that was comprised of a metal wire, specifically one in which the spring characteristics are approximately between 5 and 7 dies hard, as it is obvious to change the spring characteristics of a material in order to achieve a desired spring resiliency for a preferred application of the spring. It is also obvious for the medium for holding the clasp to that of a bracelet, necklace, etc, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

[9] Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson, US-2,811,024 in view of Guild, 755,654.

Thompson teaches of a bezel setting in a ring as described in the above claims.

However, Thompson fails to disclose expressly that the bezel consists of seat beads helping to retain the jewel.

Guild teaches of a jewel setting possessing a bur (e) and bead (f) in Figs. 3 and 4 whose purpose serve according to part 2, line 5, "forming a bur which will serve to retain a jewel (d) in position in its setting," which happens to contact the jewel from above.

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the bezel taught by Thompson, to suggest an embodiment utilizing a bur or

bead as taught by Guild, in order to as Guild stated above to help retain a jewel in position in its setting.

Now as for Claim 6, Thompson teaches of a ring, Re: Claim 1, further including a pair of recesses above the seat (recesses above seat 16 and below 18 in Fig. 3 of Thompson), a seat bead (Thompson in view of (e) from Fig. 3 or 4 of Guild) positioned within each of said recesses (16-above the jewel) such that the edge of the stone is held in place between said seat beads and said seat (edge of stone 15 is between seat, 16, and seat beads from above in the recess in Fig. 3 of Thompson).

Now as for Claim 7, Re: Claim 1, Thompson teaches of a ring comprising:

(a) a band having first (9) and second portions (10);

(b) a hook (21) formed at said first portion of the band (9);

(c) a bezel (12) secured to said second portion of said band (25 onto 10), said bezel having an outside wall (12) comprising a top section (17), a bottom section (25) and a recessed center section (20), an open top (right of 17), an open bottom (14), and an inside wall defining a lumen extending between said open top and said open bottom (13), and a lumen wall having a seat (16), and at least one recess (16).

(d) a stone (15) positioned at least partially within said lumen (13) of said bezel and in contact with said seat (15 into 16); and

(e) a seat bead (Thompson in view of (e) from Fig. 3 or 4 of Guild) positioned within said recess (16-above the jewel) cooperating with said seat (16) to hold said stone (15) to said bezel (12),

wherein said hook receives (21) said recessed center section of said bezel (20) to secure said first (9) and second portions (10) of said band together (via bezel, 12).

[10] Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson, US-2,811,024.

A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S. P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made patentable. In re Klug, 333 F2d 905, 142 U.S. P.Q. 161 (CCPA 1964). Further, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Claims 8 and 9 refer structurally to that of claims 1 and 7, which have been rejected for the above reasons (see 102 and 103 rejections). Claims 8 and 9 are thus rejected due to the reasoning of the above paragraph. In addition, the method of using a lost wax casting process is not novel as Marticorena (US-3,601,178), Michaud (US-4,392,289), and others familiar in the art, teach of such a technique.

Conclusion

[11] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of mount; as well as their extreme relevance to the current application: Simon, D114, 649; Ouzounian, 5,848,539; Kennedy, 5,036,682; Tranzer, 5,377,506; Vitau, 4,292,818; Mestekin, 1,440,229; Katz, 6,453,701; Lutrario, 2,763,140; Gabel, 5,735,144; Bergagnini, 5,596,887; Sandberg et al., 5,419,158; Reneer, 3,898,869; Itzkowitz, D473,812; Schunk et al., 4,794,766; Steinhauer et al., 6,490,886; Butler, 6,568,213.

[12] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is 703-305-4805. The examiner can normally be reached on 7:30 am - 5:00 pm M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

David Reese
Examiner
Art Unit 3677

ROBERT J. SANDY
PRIMARY EXAMINER

ROBERT J. SANDY
PRIMARY EXAMINER